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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,958	01/18/2001	Bulent Dervisoglu	260/085 US	9164
23639	7590	02/17/2004	EXAMINER	
BINGHAM, MCCUTCHEON LLP THREE EMBARCADERO, SUITE 1800 SAN FRANCISCO, CA 94111-4067			DOOLEY, MATTHEW C	
			ART UNIT	PAPER NUMBER
			2133	
DATE MAILED: 02/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Candidate(s)
	09/765,958	DERVISOGLU ET AL.
	Examiner	Art Unit
	Matthew C. Dooley	2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 December 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 15-30 is/are pending in the application.
- 4a) Of the above claim(s) 24-30 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 15-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 January 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 24-30 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The invention of claims 24-30 are specifically drawn to a method of testing a plurality of virtual circuit blocks directly, whereas claims 1 and 15-23 are drawn to testing means that utilize control circuit blocks, and more specifically control blocks that are utilized to control the testing of virtual circuit blocks, thus restricting direct virtual circuit block testing.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-30 are withdrawn from consideration as being directed to a non-elected invention (See 37 CFR 1.142(b) and MPEP § 821.03). Claims 24-30 will need to be cancelled by the Applicant before the case can be put into condition for allowance.

Information Disclosure Statement

2. The information disclosure statement filed 12/03/2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but only U.S. 6,269,467 (Chang et al.) has been considered. The remaining items not been considered as part of this IDS, however, the examiner would like to point out that the remaining references correspond to the references cited to the applicant in the prior office action mailed 07/29/2003. There is no need to resubmit these

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references in an IDS, as the examiner has already considered these references relevant to the application and thus cited them in the prior office action.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 15-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8, 12-16 of U.S. Patent No. 6,631,504, Dervisoglu et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims 1-5, 8, and 12-16 of U.S. 6,631,504 read on claims 1, 15-23 of the current application.

Dervisoglu '504 teaches to a top level circuit block that comprises a chip access port controller, as well as plurality of lower level test control circuit blocks connected to the top level control block, wherein each lower level block comprises a SAP controller, wherein test operation is transferred upward and downward within the hierarchical test structure (Claim 1). Furthermore the limitations of claim 15 are encompassed by claims 1 and 2 of Dervisoglu '504. The limitations of claim 16 are encompassed by claims 1 and 2 of Dervisoglu '504. The limitations of claim 17 are encompassed by claims 1 and 5 of

Dervisoglu '504. The limitations of claim 18 are encompassed by claims 1 and 3 of Dervisoglu '504. The limitations of claim 19 are encompassed by claims 1,7, and 8 of Dervisoglu '504. The limitations of claim 20 are encompassed by claims 12 and 13 of Dervisoglu '504. The limitations of claim 21 are encompassed by claims 12 and 13 of Dervisoglu '504. The limitations of claim 22 are encompassed by claims 14 and 16 of Dervisoglu '504. The limitations of claim 23 are encompassed by claims 12 of Dervisoglu '504.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Dooley whose telephone number is (703) 306-5538. The examiner can normally be reached on M-F 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (703) 305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew Dooley
Matthew Dooley
Examiner AU 2133
02/11/04

Albert Decady
ALBERT DECADY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100